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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,306	07/07/2000	WILSON ZEHR	51001.P001.	7042

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SCHWABE, WILLIAMSON & WYATT, P.C.
PACWEST CENTER, SUITES 1600-1900
1211 SW FIFTH AVENUE
PORTLAND, OR 97204

EXAMINER

SALAD, ABDULLAHI ELMI

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 03/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/581,306

Applicant(s)

ZEHR ET AL.

Examiner

Salad E Abdullahi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Detailed Action

1. This application has been reviewed. Original claims 1-18 are pending. The rejection cited stated below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-9, and 11-14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell U.S. Patent No. 5,805,810, and further in view of Yacoub U.S. Patent No. 6,452,692

As per claim 1, 5, and 11, Maxwell, discloses a mail delivery system for delivering a mail to intended recipient comprising:

a print server (see fig. 2, element 18) which includes:

a storage device (see fig. 2, element 18); and

a processor connected to the storage device (see fig.2, element 18),

the storage device storing:

a program for controlling the processor (see col. 3, lines 20-33 and see col.5, lines 18-60); and

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the processor operative with the program to receive an electronic message that includes message attributes including a message recipient determine a recipient physical address responsive to the message recipient attribute contained within the electronic message compare the message recipient physical address with the plurality of printing locations (see col. 3, lines 20-33 and see col.5, lines 18- 60).

Maxwell is silent: the print server includes:

- the database contains attributes of a plurality of printing locations;
- receiving print criteria (attributes);
- query the printing locations having a desired set of attributes responsive to the printing criteria attributes contained within the electronic message;
- select one of the printing locations; and
- send the electronic message to the selected printing location.

Yacoub, in analogous art discloses a print server system for receiving preference for print jobs including:

- the database contains attributes of a plurality of printing locations (see col. 14, lines 17-67);
- receiving print criteria (attributes) (see the abstract);
- query the printing locations having a desired set of attributes responsive to the

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printing criteria attributes contained within the print request (see the abstract and fig. 2, lines 28-60).

select one of the printing locations (see the abstract and fig. 2, lines 28-60); and
send the electronic message to the selected printing location (see the abstract and fig. 2, lines 28-60). Therefore, it would have been obvious to having ordinary skill in the art presented with teaching of Yacoub to Modify Maxwell by utilizing the print job processing mechanism as taught by Yacoub in order to enable network users to only choose job-relevant preferences such as the quality and speed without having to determine which printer to send the print job [see col. 2, lines 17-20].

In considering claims 2, Yacoub discloses a system, wherein the processor is further operative with the program to:

receive replies from the printing locations responsive to the query (see col. 15, lines 19-36); and

select one of the printing locations responsive to the replies (see col. 15, lines 19-36).

In considering claims 4, Maxwell discloses a system, wherein the database further including a plurality of advertisements, advertising attributes and recipient demographics, in which the processor is further operative with the program to attach the selected advertisements to the electronic message (see col. 14, lines 30-35).

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In considering claim 6, Yacoub, discloses a system, wherein information from each of the printing stations is stored at a intermediate device (see fig. 4, and col. 8, lines 9-67).

In considering claim 7-9, and 12-14, Yacoub, discloses a system, wherein the information about the printer includes geographic location, printing capability or capacity (see col. 14, lines 17-67).

4. Claim 3, 10 and 15, are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell U.S. Patent No. 5,805,810, and Yacoub U.S. Patent No. 6,452,692 as applied to claim 1 above, and further in view of Heiden U.S. Patent No. 6,408,286.

In considering claims 3, 10 and 15. Although, Maxwell and Yacoub disclose substantial features of the claimed invention, they are silent the database: storing a user record, said record having a counter measuring use of the mail delivery system and operative with a promotional program to effect awarding of prizes to the user.

Heiden in analogous art, discloses a system a promotional program used within mail delivery system, including a user record which contains plurality of demographic information and/or indications of the behavior or status of the target audience or users (i.e. income or age and other statistics which could obviously include a measure of the system usage) (see col. 7, line 30 to col. 8, line 67). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention presented with the teaching of Heiden to modify the system presented by

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Maxwell and Yacoub by employing the product distribution mechanism with promotional program as taught by Heiden such that user can be rewarded with their frequent interaction with the system, thereby enhancing the mail distribution system productivity.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Heiden U.S. Patent No. 6,408,286.

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In considering claim 16, Heiden, discloses system for dynamically arranging advertisement with in a printed product delivered to recipient, comparing:

storing a plurality of advertisements within an electronic storage system (third party advertising database) (see col. 7, line 62 to col. 8, line 67);

identifying which of the stored advertisements are in a ready state (authenticated and/or processed) (see col. 7, line 62 to col. 8, line 67);

for each ready state advertisement, setting a base priority value (checking restriction criteria)(see col. 7, line 62 to col. 8, line 67);

resorting the list according to ad affinity selecting a subset of ads to be used from the resorted list; and printing the selected ads onto a printed medium delivered to the recipient (see fig. 2, and col. 5, line 12-51).

In considering claim 17, Heiden discloses a system, wherein the step of resorting the list includes:

associating an ad type with each advertisement on the list;

comparing the ad type of a first ad on the list with the ad type of a second ad on there sorted list (see fig. 2, and col. 5, line 12-51); and

reordering the second ad on the resorted list if the first ad type is incompatible with the second ad type.(see fig. 2, and col. 5, line 12-51).

In considering claim 18, Heiden discloses a system further including the steps of

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accessing demographic information of the recipient (see col. 7, line 62 to col. 8, line 67);
and
modifying the base priority value responsive to the accessed demographic information
(see col. 7, line 62 to col. 8, line 67).

CONCLUSION

7. The prior art made of record and relied upon is considered pertinent to the applicants disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Abdullahi E. Salad** whose telephone number is **(703) 308-8441**. The examiner can normally be reached on Monday to Friday from **8:30 AM to 5:00 PM**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Etienne, Ario** can be reached at **(703)308-7562**. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **(703)305-3900**.

Any response to this action should mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, DC 20231

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or faxed to:


(703) 746-7238, (after final communications)

(703) 746-7239, (Official communications)

(703) 746-7240, (Non-Official/Draft).

As

03/21/2003


ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100